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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,377	06/28/2005	Yoshiaki Nabuchi	NABUCHI	3839

1444 7590 03/10/2009  
BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER
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BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1612

MAIL DATE	DELIVERY MODE
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03/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/509,377

**Applicant(s)**

NABUCHI ET AL.

**Examiner**

Barbara P. Badio

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 28 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 3/8/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**First Office Action on the Merits**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for salts or esters of the claimed compounds, does not reasonably provide enablement for hydrates thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Factors to be considered in making an enablement rejection are summarized as:

- a) the quantity of experimentation necessary,
- b) the amount of direction or guidance presented,
- c) the presence or absence of working examples,
- d) the nature of the invention,
- e) the state of the prior art,
- f) the relative skill of those in the art,
- g) the predictability or unpredictability of the art, and
- h) the breadth of the claims.

*In re Colianni*, 195 USPQ 150 (CCPA 1977). *In re Rainer*, et al., 146 USPQ 218 (CCPA 1965). *Ex parte Formal*, 230 USPQ 546 (BPAI 1986).

a) Determining if a particular compound would form a solvate or hydrate would require synthesis and recrystallization of the compound solvate or hydrate using a variety of solvents, temperatures and humidities. The experimentation for solvates or hydrates is potentially open-ended.

b) The specification merely mentions the Applicant's intention to make solvates and hydrates, without teaching the preparation thereof.

c) While the claims recite solvates and hydrates, no working examples show their formation. As stated in Morton International Inc. v. Cardinal Chemical Co., 28 USPQ2d 1190, 1194 (Fed.Cir. 1993):

The specification purports to teach, with over fifty examples, the preparation of the claimed compounds ... However ... there is no evidence that such compounds exist ... [T]he examples ... do not produce the postulated compounds ... [T]here is ... no evidence that such compounds even exist.

The specification shows no evidence of the formation and actual existence of solvates and hydrates. Hence, Applicant must show formation of solvates and hydrates or limit the claims accordingly.

d) The nature of the invention is chemical synthesis of solvates and hydrates, which involves chemical reactions.

e) The state of the art recognizes that the formation, composition and therapeutic activity of solvates and hydrates are unpredictable. The Federal Circuit has recognized a solvate as an example of a polymorph or pseudopolymorph (emphasis added):

"Polymorphs" are distinct crystalline structures containing the same molecules. These structural differences can affect various properties of the crystals, such as melting points and hardness (e.g., graphite and

diamonds are both crystalline forms of carbon) .... [P]seudopolymorphs are often loosely called polymorphs ... Pseudopolymorphs not only have their molecules arranged differently but also have a slightly different molecular composition. A common type of pseudopolymorph is a solvate, which is a crystal in which the molecules defining the crystal structure "trap" molecules of a solvent. The crystal molecules and the solvent molecules then bond to form an altered crystalline structure.

SmithKline Beecham Corp. v. Apotex Corp., 74 USPQ2d 1398, 1409 (Fed.Cir. 2005).

The same rationale obtains for hydrates; solvates in which the solvent is water. Souillac, et al., Characterization of Delivery Systems, Differential Scanning Calorimetry, pages 217-218 (in Encyclopedia of Controlled Drug Delivery, 1999, John Wiley & Sons, pages 212-227), recognize that different polymorphs of the same drug can have different therapeutic activity (emphasis added):

Because different polymorphic forms of the same drug exhibit significant differences in their physical characteristics, therapeutic activity from one form to another may be different. Studying the polymorphism of a drug and the relative stability of the different polymorphs is a critical part of pre-formulation development.

Further, Vippagunta et al. (Advanced Drug Delivery Reviews, 48 (2001), pages 3-26) state "Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated in to the crystal lattice of a compound is complex and difficult." See page 18, section 3.4.

f) The artisan using Applicant's disclosure to prepare the claimed solvates and hydrates would be, e.g., an experienced process chemist with at least a BS chemistry degree.

g) Chemical reactions are known as unpredictable. *In re Marzocchi, et al.*, 169 USPQ 367, 370 (CCPA 1971); *In re Fisher*, 166 USPQ 18, 24 (CCPA 1970). See above regarding the unpredictability of solvate and hydrate formation.

h) The breadth of the claims includes thousands of compounds of the instant formula (1) as well as presently unknown compounds embraced by the terms solvates and hydrates. See MPEP 2164.01(a), discussed supra, justifying the conclusion of lack of enablement commensurate with the claims. Undue experimentation will be required to practice Applicant's claimed invention.

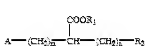
### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jo et al. (WO 0142186, see English translation US6,737,417).

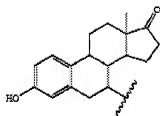
Jo et al. teaches compounds with hydroxycarbonyl-halogenoalkyl derivatives side chain of the formula:



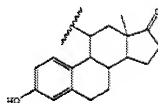
(2)

having increased activity after oral administration

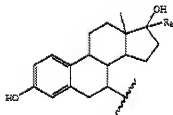
(see the entire article, especially Abstract; col. 4, line 22 – col. 8, line 55). The reference teaches A groups such as



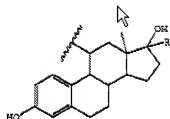
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(19)

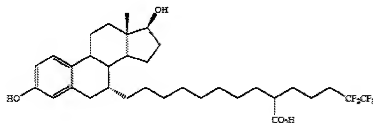


(18)



(20)

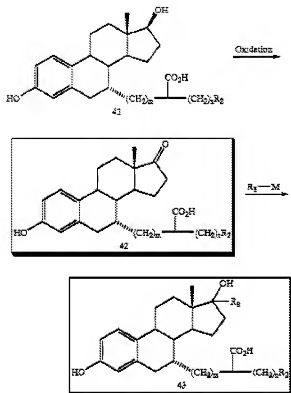
wherein  $R_8$  represents **saturated or unsaturated alkyl groups** such as  $C_1$ - $C_5$  alkyl,  $C_2$ - $C_5$  alkenyl or  **$C_2$ - $C_5$  alkynyl** (see col. 8, lines 35-38). The reference exemplifies compounds such as



(Table 1, Examples 12-

26, 36-39). Jo also teaches processes such as (a) oxidation of the 17-hydroxyl group by Jones oxidation, PCC oxidation, etc. to produce the corresponding 17-oxo derivative

and (b) the alkylation of the 17-oxo derivative with  $R_8$ -M wherein  $R_8$  is as defined above and M is a metal with the production of the 17-hydroxy-17-alkyl-derivative (see below):



(see col. 26, Scheme 9; Process 9,

col. 44, lines 9-23).

The instant claims differ from the reference by reciting compounds not exemplified by Jo et al., i.e., 17-oxo or 17-hydroxyl-17-alkynyl derivatives. However, the reference teaches said 17-substituents (see A groups above) and, therefore, the claimed compounds would have been obvious to the ordinary artisan in the art at the time of the present invention. The motivation would have been on the desire to increase activity of the compounds after oral administration as taught by Jo et al.



Claim 10 further differ from the reference by reciting the oxidation reaction is performed by Oppenauer oxidation. However, Oppenauer, like Jones oxidation, PCC oxidation and Swern oxidation, is a conventional oxidation method known in the chemical art (see for example, US 4,888,323: col. 3 lines 31-36; US 5,703,067: col. 10, lines 56-58; US 6,177,420: col. 8, lines 58-63) and, thus, the skilled artisan would have the reasonable expectation that Oppenauer oxidation would also be useful in the oxidation process as taught by Jo.

#### ***Telephone Inquiry***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/  
Primary Examiner, Art Unit 1612